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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,272	06/26/2001	Jost-Ulrich Kuegler	13287-002001	2448

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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

# Office Action Summary

Application No.

09/869,272

Applicant(s)

KUEGLER, JOST-ULRICH

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-13 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a belt or strap with an overhang and eyelet as recited in claim 9. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 9 is finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. All of the elements that the applicant refers to as a strap with an overhang and eyelet" as required in claim 9 is not clear.

4. Claims 7, 9, 11 and 13 are finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

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The specification as originally filed does not provide support for the teaching of "fabric covering" as now recited in claims 7, 11 and 13 and "a belt" as now recited in claim 9. Accordingly these limitations now added to the claims are considered to be New Matter. Applicant is required to cancel the new matter in the response to this office action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 6-7 and 9-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst in view of Taylor and further in view of GB 1326711, hereinafter GB.

Papst discloses in the embodiment of Fig 3, a children's rocking toy in the form of a stylized horse, having a one-piece basic body [col 1 lines 14-18] made of flexible synthetic material [col 1 lines 14-34] which has a simply curved rocking surface forming the base [frame 15] of the rocking toy and a seat region 21 molded [col 2 lines 37] into it, the basic body has, at its two longitudinal end regions, two curvatures in the form of a horse's head 21a and of a horse's rear part 21b, respectively, each curvature having a height relatively greater than the molded-in seat region, the cross section of the basic body widens from its upper, narrow side, which forms the horse's head, seat region and horse's rear part, towards the curved rocking surface in a continuous and uniform contour of the side surfaces [Fig 3] as recited in claim 1.

Papst does not disclose the seat region is molded a good distance into the basic body and thereby forms a backrest region and the flexible synthetic material is a foam as recited in claim 1, the basic body is manufactured, in particular cut, from a foam block as recited in claim 6 and the basic body is covered with a fabric covering as recited in claim 7 and the rocking surface has a non-slip backing made of leather or imitation leather and the backing is connected to the basic body by a zipper fastener or by button or snaps or by a belt or strap with an overhang and eyelet for exchanging or for cleaning or washing purposes as recited in claim 9.

Taylor teaches the concept of providing non-slip surface 14 made out of roughened leather. It would have been obvious to provide the curved rocking surface in the device of Papst to include the non-slip backing as disclosed by Taylor, in order to prevent the device from sliding. Additionally, it would have been obvious to connect the backing to the curved rocking surface by way of a zipper fastener or by button or snaps or by a belt or strap in order to prevent "premature separation" of the backing from the curved rocking surface.

With respect to the seat region is molded a good distance into the basic body and thereby forms a backrest region, Papst discloses in the embodiment of Fig 1 the seat region is molded a good distance into the basic body. It would have been obvious to modify the seat region in the embodiment of Fig 3 in device of Papst to be molded a good distance into the basic body as disclosed by the embodiment of Fig 1 of the same reference, in order to ensure safe handling and operation by a child.

GB is cited to show a desirability to make a rocking toy made out of a block of foam covered with a fabric covering [waterproof sheet material or fabric] [col 1 last two lines]. It would have been obvious to make the device of Papst out of a block of foam as disclosed by GB in order to make the device safe for the children by avoiding hard or sharp edges. Also, it would have been obvious to provide the device with waterproof sheet material or fabric to make the device suitable for outdoor play.

7. Claim 12 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst, Taylor and GB and further in view of Curry, Sr., hereinafter Sr.

Modified device of Papst discloses most of the element of this claim as applied to claims 1-3, 6-7 and 9-11 above but does not disclose the tail and the mane of the horses head consist of real, artificial or stylized hairs.

Sr teaches the concept of providing a rocking horse in which the tail and the mane of the horse's head consist of artificial hairs [col 7 line 44]. It would have been obvious to provide the rocking horse of Sr with artificial hairs in its tail and mane as disclosed by Sr in order to make the device more realistic.

8. Claims 8 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst, Taylor and GB and further in view of Official Notice hereby taken that having seat region has a leather layer as the saddle is well known in the art.

Modified device of Papst discloses most of the elements of claim 8 as applied to claims 1-3, 6-7 and 9-11 above but does not disclose the seat region has a leather layer as the saddle.

In view of Official Notice above it would have been obvious to provide the device of Papst with a leather saddle in order to have a more comfortable seat. [see also US Patent number 4,848,067]

***Response to Arguments***

9. Applicant's arguments filed 12/27/02 have been fully considered but they are not persuasive.

The rejection of claims 1, 8-9 and 11-13 in the last office action under 35 U.S.C. 112, first paragraph, regarding New Matter is hereby withdrawn.

In response to applicant's argument in page 8-second paragraph, the device of Papst clearly discloses a base [frame 15].

In response to applicant's argument that there must be something in the reference that suggests the combination or the modification, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the

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teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). In this case, the artisan would have been motivated to provide the curved rocking surface to include the non-slip backing in order to prevent the device from sliding and to connect the backing to the curved rocking surface by way of a zip fastener or is a button in order to prevent "premature separation" of the backing from the curved rocking surface. Additionally, the artisan would have been motivated to make the device of Papst out of a block of foam in order to make the device safe for the children by avoiding hard or sharp edges.

***Allowable Subject Matter***

10. Claims 4-5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



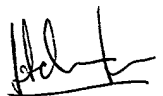
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
JACOB K. ACKUN  
PRIMARY EXAMINER  
GROUP 3200

FF  
January 17, 2003